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OFFICE OF PETITIONS

In re Application of :
Bjorn Bengtsson : DECISION ON APPLICATION
Application No. 09/987,991 : FOR
Filed: November 16, 2001 : PATENT TERM ADJUSTMENT
Atty Docket No. 59589.000028 :
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This is a decision on the "REQUEST (APPLICATION) FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT," filed November 30, 2004. Applicant requests that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from zero (0) days to one hundred twenty-eight (128) days.

The application for patent term adjustment is **GRANTED** to the extent indicated herein.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the notice of allowance is two hundred **(200)** days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On August 31, 2004, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is 0 days. On November 30, 2004, applicant timely¹ submitted an application for patent term

¹ PALM records indicate that the Issue Fee payment was also received on November 30, 2004.

adjustment (with required fee). Applicant asserts entitlement to a patent term adjustment of 128 days on the basis that i) the Office did not mail a first action under 35 U.S.C. 132 until, April 9, 2003, 14 months and 11 days, after the application fulfilled the requirements of 35 U.S.C. 371, on January 29, 2002; and ii) the Office mailed the notice of allowance on August 31, 2004, four months and 117 days, after receipt of their response to Office action filed January 6, 2004.

Applicant states that this patent is not subject to a terminal disclaimer.

A review of the application history confirms that the number of days in the period of adjustment pursuant to § 1.703(a)(1) for the Office's mailing of a first action under 35 U.S.C. 132 on April 9, 2003, is 83 days. The instant application was filed on November 16, 2001 under 35 U.S.C. 111(a), not under 35 U.S.C. 371. Thus, this period was counted beginning on the day after the date that is fourteen months after the date on which the application was filed under 35 U.S.C. 111(a), January 17, 2003, and ending on the date of the mailing of the first action under 35 U.S.C. 132, April 9, 2003. Applicant erred in calculating this period as they used a beginning date of March 29, 2003, fourteen months after January 29, 2002, the date of filing of their response to the Notice to File Missing Parts of Application.

However, applicant is correct that a period of adjustment of 117 days, and not a period of reduction of 192 days, should have been entered. Applicant's response to the non-final rejection mailed October 6, 2003, was accepted as having been received in the Office by facsimile transmission on January 6, 2004. This was within the three-month period set forth in § 1.704(b). (The response was re-supplied on July 16, 2004, with evidence of timely submission on January 6, 2004). Thus, entry of a period of reduction of 192 days is not warranted.

Moreover, the Office did not mail a response until August 31, 2004. Using the date of receipt of the response, January 6, 2004, the period of Office delay is 117 days.

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the notice of allowance is two hundred (200) days (117 + 83 days).

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application file is being forwarded to the Office of Patent Publication for issuance of the patent.

Telephone inquiries specific to this matter should be directed to Nancy Johnson, Senior Petitions Attorney, at (571) 272-3219.

*Karin Ferriter
for*

Karin Ferriter
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy

Attachment: Copy of Revised PAIR